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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,063	02/04/2004	Murray S. Toas	D0932-00447	5057

8933 7590 07/12/2005

DUANE MORRIS, LLP  
IP DEPARTMENT  
ONE LIBERTY PLACE  
PHILADELPHIA, PA 19103-7396

EXAMINER
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MATZEK, MATTHEW D

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/772,063

**Applicant(s)**

TOAS ET AL.

**Examiner**

Matthew D. Matzek

**Art Unit**

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 18-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-17 and 38-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The Amendment and Remarks submitted by Applicant dated 4/20/2005 have been accepted and entered into the Record. Claims 20-37 have been canceled along with claims 11 and 19. According to the amended claims, claim 18 has also been canceled. Claims 1-10, 12-17, and 38-41 remain active. The title has been amended to overcome the previously applied objection. Claim 7 has been appropriately amended to overcome the previous rejection under 35 U.S.C. § 112. The rejections under 35 U.S.C. § 103 have been withdrawn as necessitated by amendment. The previously applied art failed to either teach or anticipate the application of an antifungal/antimicrobial agent present in an amount of less than 200 ppm in the cellulosic facing.

***Response to Amendment***

***Claim Rejections - 35 USC § 103***

2. Claims 1-10, 12-17, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay et al. (US 2004/0185204) and further in view of Capps (US 6,680,127).

a. Fay et al. teach a fungi-growth inhibiting facing of a building insulation assembly including a central field portion (Abstract). The central field portion may comprise randomly oriented, entangled, glass fibers that are bound by an adhesive binder [0031]. The insulation may be faced with kraft paper with a basis weight of 30 to 40 pounds/3000 ft<sup>2</sup> [0002]. The kraft paper facing may comprise a fungicide, biocide and pesticide and may be adhered via a bituminous adhesive [0007].

b. The biocide disclosed by Fay et al. is silver zeolyte, which is commonly used in protecting food packages through its release of silver and is sold as KATHON®, by ROHM AND HAAS®, a biocide fungi-growth inhibiting agent designed for insulation articles [0047]. As it is commonly used in protecting food packages the said biocide is

presumed to be nontoxic and noncarcinogenic to humans and does not present significant toxic residue.

c. The article of Fay et al. is necessarily heat resistant to temperatures of 250 °F and molten bituminous adhesive as the applied reference teaches the application of bituminous adhesive to adhere the kraft paper facing to the insulation. Claim 16 is rejected as the bituminous layer may function as a vapor barrier [0050].

d. The R-values disclosed in Applicant's claim 8 are consistent with those of common fiberglass insulation articles

(<http://www.furnacecompare.com/faq/definitions/insulation.html>, 10/15/04). Insulation

capability (R-value) is generally given on a per inch basis and a final R-value is calculated by multiplying the R-value per inch by the total thickness of the insulation.

Fiberglass batts have an average R-value of 3.25 per inch and are known to have total R-values up to 30 ([http://www.progress-](http://www.progress-energy.com/aboutenergy/learningctr/savingtips/rvalues.asp)

[energy.com/aboutenergy/learningctr/savingtips/rvalues.asp](http://www.progress-energy.com/aboutenergy/learningctr/savingtips/rvalues.asp), 10/15/04). Fay et al. disclose

a fiberglass insulation comprising fiberglass, binder and biocide, but are silent as to the R-values of said invention. It is reasonable, however to presume that since the prior art meets the physical and chemical limitation of fiberglass batts and the body of the claim the said featured property is inherent to said insulation article thus providing the present invention the desired physical properties.

e. The publication of Fay et al. is silent as to the application of an antifungal/antimicrobial agent in the amount of less than 200 ppm in the cellulosic facing.

f. Capps teaches an insulative board comprising paper facings comprising an antifungal agent on said facings in an amount of 100 ppm (Abstract, col. 2, lines 1-6, and col. 7, lines 1-6). Capps also discloses an extensive list of antifungal agents available for use in insulative articles (col. 3, line 18 – col. 6, line 30).

g. Since Fay et al. and Capps are from the same field of endeavor, insulative articles, the purpose disclosed by Capps would have been recognized in the pertinent art of Fay et al.

h. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the kraft paper facing of Fay et al. with the biocide at the level disclosed by Capps motivated by the desire to successfully create a microbial and fungicidal resistant insulative article.

i. It should be noted that optimizing the amount or type of biocide included in the insulation article or restraining its content within set values are result effective variables. For example, manipulating the quantity of antifungal/ antimicrobial agent on the cellulosic facing to attain a predetermined value or be in accordance with a standard/test. Biocide/fungicide selection is also a result effective variable. Therefore, it would have been obvious for a person having ordinary skill in the art at the time the invention was made to have made the Fay et al. invention to contain a antifungal/antimicrobial level able to pass ASTM C1338, ASTM D-2020, TAPPI Test T487, or a combination thereof.

*In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

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***Response to Arguments***

3. Applicants arguments serve to distinguish the amended claims over the previously applied art rather than addressing the rejections as applied to the previously active claims. The amended claims have been addressed supra.

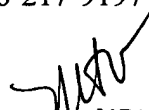
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdm

  
**NORCA TORRES**  
**PRIMARY EXAMINER**